

**Remarks**

Claim 7 has been amended herein. Claims 19 and 20 have been added. Claims 1-20 are now pending in the application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Claim 7 has been corrected to depend from claim 3.

Support for new claims 19 and 20 is also found in the Specification, drawings and the original claims (e.g Figure 120; Page 48, line 8-11). The subject matter recited in independent claim 19 generally corresponds to the subject matter recited in claims 1 and 11 and therefore claim 19 and claim 20 which depends from claim 19 should be allowable for at least the same reasons discussed below with respect to claims 1 and 11.

**The Pending Claims Are Not Anticipated by the Applied Art**

Pending claims 1-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lewis et al. 6,082,616 ("Lewis").

These rejections are respectfully traversed.

**The Applied Reference Does Not Disclose or Suggest the Features and Relationships Recited in Applicants' Claims**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

#### The Lewis Reference

Lewis is directed to an automated banking machine enclosure. The machine includes a keypad mounting plate (62) which attaches to an upper wall (58) through "a tab and slot arrangement" (Column 4, lines 17-21).

**The Features Recited in Applicants' Claims  
Patentably Distinguish Over Lewis**

In the Action pending claims 1-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lewis. These rejections are respectfully traversed. Applicants' response to these rejections is based on the Office's referenced interpretation of Lewis. Thus, any change in the Office's interpretation of Lewis shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that Lewis does not contain all the elements, relationships and/or steps of the claimed invention arranged in the manner recited in the claims. The features, relationships and/or steps recited in Applicants' claims patentably distinguish over the Lewis reference.

**Claim 1**

Claim 1 is an independent claim directed to a cash dispensing automated banking machine. The machine comprises a housing and a cash dispenser. The housing includes at least two sheet metal parts. At least one of the parts includes at least one tab. Also a second one of the parts includes at least one slot. Claim 1 also recites that the at least one tab includes a base portion with at least one groove therein. The groove has a depth which is less than the thickness of the at least one tab. In addition claim 1 recites that the at least one tab extends through the at least one slot and is bent at the groove to lie adjacent a surface of the second part.

The Action asserts that Lewis shows parts (58) and (62) with tabs and slots that securely fasten the parts (62) and (58) together. However such tabs and slots of Lewis do not disclose or

suggest each of the features and relationships recited in claim 1. For example the following features recited in claim 1 are not disclosed or suggested in Lewis:

- wherein the at least one tab includes a base portion with at least one groove therein,
- wherein the at least one groove has a depth which is less than the thickness of the at least one tab,
- wherein the at least one tab extends through the at least one slot and is bent at the groove to lie adjacent a surface of the second part.

Although Lewis shows a tab on a keypad mounting plate (62) which appears to be bent. Lewis does not disclose or suggest that this tab or any other tab includes a groove therein adjacent a base portion of the tab or anywhere else on the tab. Further Lewis does not disclose or suggest at least one groove in a tab that has a depth which is less than the thickness of the at least one tab. In addition Lewis does not disclose or suggest a tab that is bent at a groove to lie adjacent a surface of a part that includes a slot through which the tab is inserted.

Further these features would not be inherent in Lewis. Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a

cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

Figure 2 of Lewis shows a tab on a keypad mounting plate (62) which appears to be bent at right angles. Such a tab could have been produced by bending a generally planar sheet metal projection extending from the plate (62) using a press or other part manufacturing tool. There is no requirement in Lewis for such a projection to include a groove in the location of the bend. Thus it would not be inherent in Lewis to use a tab that includes a base portion with at least one groove therein.

Lewis does not disclose each and every element, relationship, and feature of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Hence, Applicants' claim 1 patentably distinguishes over the Lewis reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection has been overcome. It follows that claims 2-10 which depend from claim 1 are likewise allowable.

#### Claim 11

Claim 11 is an independent claim directed to a method of forming a housing for an automated banking machine which includes a cash dispenser. The method comprises (a) providing at least two sheet metal parts. A first one of the parts includes at least one tab and a second one of the parts includes at least one slot therethrough. The at least one tab includes a groove therein with a depth that is less than the thickness of the at least one tab. The method also

comprises (b) inserting the at least one tab into the at least one slot; and (c) bending the at least one tab at the location of the groove to a position adjacent a surface of the second part.

As discussed previously, the Action asserts that Lewis shows sheet metal parts (58) and (62) with tabs and slots that securely fasten the parts (62) and (58) together. However such tabs and slots of Lewis do not disclose or suggest each of the features and relationships recited in claim 11. For example the following steps and features recited in claim 11 are not disclosed or suggested in Lewis:

- **wherein the at least one tab includes a groove therein,**
- **a groove therein with a depth that is less than the thickness of the at least one tab,**
- **bending the at least one tab at the location of the groove to a position adjacent a surface of the second part.**

Although Lewis shows a tab on a keypad mounting plate (62) which appears to be bent. Lewis does not disclose or suggest that this tab or any other tab includes a groove therein. Further Lewis does not disclose or suggest at least one groove in a tab that has a depth which is less than the thickness of the at least one tab. In addition Lewis does not disclose or suggest a step of bending a tab at the location of a groove to a position adjacent a surface of a part that includes a slot through which the tab is inserted.

Further these features would not be inherent in Lewis. Figure 2 of Lewis shows a tab on a keypad mounting plate (62) which appears to be bent at right angles. Such a tab could have been produced by bending a generally planar sheet metal projection extending from the plate (62) using a press or other part manufacturing tool. There is no requirement in Lewis for such a projection to include a groove in the location of the bend. Thus it would not be inherent in Lewis to bend a tab at the location of the groove in the tab.

Lewis does not disclose each and every element, relationship and step of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Hence, Applicants' claim 11 patentably distinguishes over the Lewis reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection has been overcome. It follows that claims 12-18 which depend from claim 11 are likewise allowable.

#### **The Dependent Claims**

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claims have been previously shown to be allowable. Thus, it is respectfully submitted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recites specific features, relationships, and/or steps that patentably distinguish the claimed invention over the applied art. Lewis does not disclose or suggest the features, relationships, and/or steps that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features, relationships, and/or steps.

For example, with respect to claims 3-7 and 13-17, Lewis does not disclose or suggest a slot that includes an outwardly bowed portion which provides the slot with a wider center relative to the thickness of the slot at each end. Also for example, with respect to claims 10 and 18, Lewis does not disclose or suggest that a slot extends through a loop and the tab extends around the edge of the loop.

#### Additional Claim Fees

No fee is due with the submission of this Response. However, for any other fees due associated with the prosecution of this Application, please charge Deposit Account No. 09-0428 of Diebold Self-Service Systems.

#### Conclusion

Each of Applicants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



Ralph E. Jocke      Reg. No. 31,029  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000  
Customer No. 28995